

REMARKS

The Examiner's final Office Action of July 31, 2006, has been carefully considered. In the instant application, claims 1, 6-8, 11 and 12 are pending and rejected. In view of following remarks, the reconsideration and withdrawal of the present basis for rejecting the claims herein of this application is respectfully requested.

I. Discussion of the Rejection under 35 U.S.C. § 112, First Paragraph

Claims 1, 6-8, 11 and 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written requirement. Specifically, the Examiner asserts that "[t]he proviso that was added to claim 1 is new matter since the provisoing out of specific compounds that are not specifically disclosed in the specification is new matter. See Ex parte Grasselli, 231 USPQ 393." (see the Action, page 2)

Applicants respectfully traverse the instant rejection.

The first paragraph of 35 U.S.C. § 112 requires an applicant to convey with reasonable clarity to those skilled in the art that, as of the filing date, the applicant was in possession of the claimed invention. Applicants submit that the present application indeed meets the requirement. In the present application, Applicants' claimed invention is directed to compounds of formula (I) minus one specific species, 2-methyl-6-trifluoromethyl-1H-indole-3-carboxylic acid benzothiazol-2-ylamide. Applicants submit that there is ample basis for Applicants claiming such "limited genus". The specification exemplifies a plethora of species that are within this "limited genus". Thus, there is sufficient written description in the originally-filed specification that conveys with reasonable clarity to those skilled in the art that, as of the filing date, Applicants were in possession of the claimed invention, i.e., the "limited genus".

With respect to provisos added to claims during prosecution to exclude aspects of the prior art, in In re Johnson and Farnham, 194 U.S.P.Q. 187 (CCPA, 1977) (hereinafter, "In re Johnson"), the Court indicated,

Inventions are constantly made which turn out not to be patentable, and applicants frequently discover during the course of prosecution that only a part of what they invented and originally claimed is patentable. It is for the inventor to decide what bounds of protection he will seek. To deny applicants [the benefits of an earlier filing date] would...let form triumph over substance, substantially eliminating the right of an applicant to retreat to an otherwise patentable species merely because he erroneously thought he was first with the genus when he filed. (In re Johnson, at 195, 196, emphasis added).

The Court went on to rule that,

Here, as we hold on the facts of this case, the 'written description' in the 1963 application supported the claims in the absence of the limitation, and that specification, having described the whole, necessarily described the

part remaining...[U]nder these circumstances...appellants are merely excising the invention of another, to which they are not entitled, and are not creating an 'artificial subgenus' or claiming 'new matter.' (Id. at 196, emphasis added).

Furthermore, in *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993), the Board states that "the observation of a lack of literal support does not, in and of itself, establish a prima facie case for lack of adequate descriptive support under the first paragraph of 35 U.S.C. 112." [See also MPEP § 2173.05(i)].

In the present case, the proviso was added to claim 1 to exclude one specific compound cited in prior art, i.e., a compound to which Applicants are not entitled to. Such proviso does not create an "artificial subgenus" or introduce any "new matter".

Applicants also would like to point out that as *In re Johnson and Farnham* is a case decided by the Court of Customs and Patent Appeals, its ruling controls over *Ex parte Grasselli*, which was decided by the Patent and Trademark Office Board of Appeals.

In view of the aforesaid, Applicants submit that the Examiner's rejection under 35 U.S.C. § 112 is improper. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection.

II. Conclusion

In view of the above remarks, it is respectfully submitted that the present application is in condition for allowance. Early notice to this effect is, thus, respectfully requested.

Respectfully submitted,



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Date: October 6, 2006

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sanofi-aventis Docket No. DEAV2002-0056 US NP